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| APPLICATION NO.                                                                                                        | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.     | CONFIRMATION NO.            |
|------------------------------------------------------------------------------------------------------------------------|-------------|----------------------|-------------------------|-----------------------------|
| 09/755,884                                                                                                             | 01/05/2001  | Christoph Lodde      | 44815/251563            | 4102                        |
| 7590                                                                                                                   | 06/15/2006  |                      |                         | EXAMINER<br>CHANG, VICTOR S |
| Roger T. Frost, Esq.<br>Merchant & Gould, LLC<br>3200 IDS Center<br>80 South 80th Street<br>Minneapolis, MN 55402-2215 |             |                      | ART UNIT<br>1771        | PAPER NUMBER                |
|                                                                                                                        |             |                      | DATE MAILED: 06/15/2006 |                             |

Please find below and/or attached an Office communication concerning this application or proceeding.

|                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                       |                             |                                                                                                                                                                                                                                   |  |
|---------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------|-----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|--|
| <b>Office Action Summary</b>                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                          | Application No.             | Applicant(s)                                                                                                                                                                                                                      |  |
|                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                       | 09/755,884                  | LODDE, CHRISTOPH                                                                                                                                                                                                                  |  |
|                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                       | Examiner<br>Victor S. Chang | Art Unit<br>1771                                                                                                                                                                                                                  |  |
| <i>-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --</i>                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                        |                             |                                                                                                                                                                                                                                   |  |
| <b>Period for Reply</b>                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                               |                             |                                                                                                                                                                                                                                   |  |
| <b>A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.</b>                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                      |                             |                                                                                                                                                                                                                                   |  |
| <ul style="list-style-type: none"> <li>- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.</li> <li>- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.</li> <li>- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).</li> </ul> |                             |                                                                                                                                                                                                                                   |  |
| <b>Status</b>                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                         |                             |                                                                                                                                                                                                                                   |  |
| <p>1)<input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>5/19/2006</u>.</p> <p>2a)<input type="checkbox"/> This action is <b>FINAL</b>.                            2b)<input checked="" type="checkbox"/> This action is non-final.</p> <p>3)<input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i>, 1935 C.D. 11, 453 O.G. 213.</p>                                                                                                                                                                                                                                                                 |                             |                                                                                                                                                                                                                                   |  |
| <b>Disposition of Claims</b>                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                          |                             |                                                                                                                                                                                                                                   |  |
| <p>4)<input checked="" type="checkbox"/> Claim(s) <u>1-3,5-9 and 12</u> is/are pending in the application.</p> <p>4a) Of the above claim(s) _____ is/are withdrawn from consideration.</p> <p>5)<input type="checkbox"/> Claim(s) _____ is/are allowed.</p> <p>6)<input checked="" type="checkbox"/> Claim(s) <u>1-3,5-9 and 12</u> is/are rejected.</p> <p>7)<input type="checkbox"/> Claim(s) _____ is/are objected to.</p> <p>8)<input type="checkbox"/> Claim(s) _____ are subject to restriction and/or election requirement.</p>                                                                                                                                                                                                                                                |                             |                                                                                                                                                                                                                                   |  |
| <b>Application Papers</b>                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                             |                             |                                                                                                                                                                                                                                   |  |
| <p>9)<input type="checkbox"/> The specification is objected to by the Examiner.</p> <p>10)<input type="checkbox"/> The drawing(s) filed on _____ is/are: a)<input type="checkbox"/> accepted or b)<input type="checkbox"/> objected to by the Examiner.</p> <p style="margin-left: 20px;">Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).</p> <p style="margin-left: 20px;">Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).</p> <p>11)<input type="checkbox"/> The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.</p>                                                                          |                             |                                                                                                                                                                                                                                   |  |
| <b>Priority under 35 U.S.C. § 119</b>                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                 |                             |                                                                                                                                                                                                                                   |  |
| <p>12)<input type="checkbox"/> Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).</p> <p>a)<input type="checkbox"/> All    b)<input type="checkbox"/> Some * c)<input type="checkbox"/> None of:</p> <p style="margin-left: 20px;">1.<input type="checkbox"/> Certified copies of the priority documents have been received.</p> <p style="margin-left: 20px;">2.<input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____.</p> <p style="margin-left: 20px;">3.<input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).</p>                          |                             |                                                                                                                                                                                                                                   |  |
| <p>* See the attached detailed Office action for a list of the certified copies not received.</p>                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                     |                             |                                                                                                                                                                                                                                   |  |
| <b>Attachment(s)</b>                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                  |                             |                                                                                                                                                                                                                                   |  |
| <p>1)<input checked="" type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2)<input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3)<input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br/>Paper No(s)/Mail Date _____.</p>                                                                                                                                                                                                                                                                                                                                                                                                                                                                           |                             | <p>4)<input type="checkbox"/> Interview Summary (PTO-413)<br/>Paper No(s)/Mail Date. _____.</p> <p>5)<input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</p> <p>6)<input type="checkbox"/> Other: _____.</p> |  |

## **DETAILED ACTION**

### ***Introduction***

1. The Examiner has carefully considered Applicants' amendments and remarks filed on 2/10/2006. Applicants' amendments to claim 1, and cancellation of claims 10, 11 and 13-15 have been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Rejections not maintained are withdrawn. In particular, while Applicant's amendment overcomes the rejection under 35 U.S.C. 102(b)/103(a) over Mamish alone, an additional search is required, and it yielded a new reference. The new reference is found to render obvious the instant claimed invention. Applicant's comments regarding the prior art are moot in view of the new grounds of rejection.

### ***Claim Rejections - 35 USC § 103***

4. Claims 1-3, 5-8 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mamish (US 5227225) in view of Hanson et al. (US 4558888), generally as set forth in section 5 of Office action dated 3/28/2006, together with the following additional reasoning.

Mamish's invention is directed to methods for preparing masking tapes by coating a thin layer of a polyolefinic material onto a lightweight nonwoven cloth and then applying a layer of adhesive onto the opposed surface of the nonwoven cloth (Abstract).

Mamish teaches that the coated polyolefinic backing layer will both coat the surface of the cloth and invade its interstices, so that the nonwoven cloth may be said to be "embedded" (impregnated or imbued) (column 1, lines 56-61). Additionally, the polyolefin backing layer of the masking tape acts as a sealant to the discontinuous nonwoven surface and serves as a barrier layer against adhesive migration (column 1, lines 65-67).

For newly amended claim 1, which now incorporate the limitation from cancelled claim 11: "... wherein the thermoplastic resin is selected from the group consisting of acrylate resins and polyurethane resins", upon a further consideration and search, it is noted that Hanson's invention is also directed to an adhesive binding tape having a tough and flexible nonwoven backing coated on one surface with a pressure-sensitive adhesive and with a barrier (sealant) coat to seal the backing on the other surface (abstract). The barrier coat is typically a solvent-dispersible rubbery polymer which when dry on the backside of the adhesive backing laminate forms a non-tacky continuous film, which exists in the interstices of the porous backing. The barrier coat also increases the tensile strength of the tape (column 3, lines 42-58). As such, in the absence of unexpected results, it would have been obvious to one of ordinary skill in the art to substitute the polyolefinic sealant coat of Mamish with a suitable barrier rubbery material, such as a suitable rubbery polyurethane or acrylate resins, as taught by Hanson. Finally, it should be noted that, in the absence of any unexpected results and specificity, it is the Examiner's position that the instantly claimed subgenus fails to

exclude an obvious selection of a suitable rubbery material, including acrylic resins and polyurethane resins, as taught by Hansen.

6. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mamish (US 5227225) in view of Hansen et al. (US 4558888) and Hansen et al. (US 4133731), generally as set forth in section 6 of Office action dated 3/28/2006, together with the additional reasoning as set forth above.

### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S. Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H. Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*Victor S Chang*  
Victor S Chang  
Examiner  
Art Unit 1771

6/5/2006